

### **REMARKS**

Claims 1-34, 36-40, and 42-50 are pending in the present application. Claims 35 and 41 are canceled. Claims 1, 15, 17, 18, 21, 28-34, 36, and 42 have been amended. Claims 43-50 are new. Claims 1, 15, 17, 18, 21, 28, and 31 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the above amendments and the following remarks.

#### ***Claim for Priority***

It is gratefully acknowledged that the Examiner has recognized Applicants' claim for foreign priority. In view of the fact that Applicants' claim for foreign priority has been perfected, no additional action is required from Applicants at this time.

#### ***Problems Addressed by Invention***

As described in the Description of the Related Art section (specification at page 1, line 14 – page 2, line 4), one problem for a user of an image-capturing device (e.g., digital camera) is that the image-storing operation of the device becomes very burdensome. This is because the number of images captured by the user increases as time goes by. Thus, the user has to periodically transfer images out of the capturing device by recording onto a recording medium.

The present invention addresses this problem. According to one aspect of the invention, captured images are automatically transmitted out of the capturing device and received by an external apparatus, in accordance with predetermined instructions, in order to record the images to a recording medium. Thus, the user is relieved of the burden of manually selecting and transmitting images out of the capturing device because these operations are performed automatically.

***Rejection Under 35 U.S.C. § 102***

**Fredlund**

Claims 1, 2, 4, 5, 7-14, 28, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,666,215 to Fredlund et al. (hereafter “Fredlund”). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

**Synopsis of Fredlund**

Fredlund teaches a system and method by which a customer may remotely select and order photographic prints according to three basic steps:

- (1) the customer sends photographic negative film to a photofinisher (i.e., photo processing lab 14) (col. 2, lines 28-31),
- (2) the photofinisher transmits a display file to the customer (col. 2, lines 31-34), and
- (3) the customer selects images from the display file and orders the desired number and size of prints for the selected images (col. 2, lines 34-40).

After (1)-(3) occur, Fredlund teaches that the resultant order may be filled manually or automatically by the photofinisher (col. 7, lines 18-19). Please note, this does not mean that step (1) is automated. Instead, this portion of Fredlund merely teaches that, in response to receiving the order information from the customer, a computer 26 in the photofinisher may control the process of filling out the order, i.e., control the print server 104 and/or CD writer 113 to perform the necessary operations on previously scanned images.

**Fredlund Fails to Teach Every Claimed Feature**

Applicants respectfully refer the Examiner to MPEP § 2131, which sets forth the following:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claims.” *Richardson v. Suzuki Motor Co.*, 868 F2d 1226, 1236, 9 USQP2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that Fredlund does not set forth each and every element as defined in the claims. Accordingly, Applicants submit that rejection under § 102 has been obviated.

Specifically, independent claims 1 and 28 recite a delivery medium producing apparatus and method for “automatically recording a plurality of images captured by a plurality of digital cameras.” Further, these claims recite, “receiving a plurality of images, which are automatically transmitted from the plurality of digital cameras...in accordance with an instruction determined by users of the plurality of digital cameras in advance.” These features are neither taught nor suggested by Fredlund. Instead, Fredlund teaches the customer must manually send the negative film to the photofinisher (step (1) in the above Synopsis), so that the photofinisher can scan the images from the film.

Further, Applicants submit that Fredlund neither recognizes nor deals with the problems addressed by the claimed invention, i.e., the heavy burden on users to manually transfer images out of the capturing device (digital camera) to be recorded on a recording medium.

At least for the reasons set forth above, Applicants respectfully submit that independent claims 1 and 18 are allowable. Accordingly, Applicants submit that claims 2, 4, 5, 7-14, and 30 are allowable at least by virtue of their dependency on allowable claims. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**Enomoto**

Claims 15-17 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,974,401 to Enomoto et al. (hereafter “Enomoto”).<sup>1</sup> This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

As amended, independent claims 15 and 17 recite features similar to those discussed above with respect to independent claims 1 and 28. It is respectfully submitted that these features distinguish the claims over Enomoto. Thus, Applicants respectfully submit that claims 15 and 17 are allowable over Enomoto. Further, Applicants submit that claim 16 is allowable at least by virtue of its dependency on an allowable claim. Therefore, the Examiner is requested to reconsider and withdraw this rejection.

***Rejections Under 35 U.S.C. § 103***

**Fredlund**

Claims 6, 36, and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fredlund. This rejection is respectfully traversed.

**Proposed Modification Fails to Remedy Deficiencies**

Initially, Applicants respectfully submit that the Examiner’s proposed modification fails to remedy the deficiencies of Fredlund set forth above in connection with independent claims 1 and 28. Thus, Applicants respectfully submit that claims 6, 36, 41, and 42 are allowable at least by virtue of their dependency on claims 1 and 28.

---

<sup>1</sup> It is noted that the Examiner rejected the claims under § 102(b). Applicants also note the US patent to Enomoto was not issued a year before the priority date of the present application and, thus, is not a § 102(b) reference. However, it appears the Examiner is relying on the publication of Enomoto’s priority application, JP 10078918A, as the basis of this rejection.

### **Elements of Prima Facie Case Under § 103**

Applicants respectfully point out that, in order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference must teach or suggest all the claim limitations. See *In re Vaeck*, 947 F.2d 48, 20 USPQ2d 1438 (Fed.Cir.1991); also, see MPEP § 2143.

### **No Motivation for Proposed Modification**

Applicants respectfully submit that the Examiner has failed to provide any teaching, suggestion, or motivation for the proposed modifications to Fredlund. Thus, the Examiner has failed to establish a *prima facie* case of obviousness under § 103.

### **Prior Art Fails to Teach/Suggest Every Claimed Feature**

Furthermore, Applicants respectfully submit that it is improper for the Examiner to merely assert that certain claimed features are “old and well known” without providing some objective evidence of record to support these assertions. Further, Applicants point out that MPEP § 2143.03 sets forth the following requirements for a proper rejection under 35 U.S.C. § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.  
*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Thus, unless the Examiner can point out a particular teaching or suggestion in the prior art for the allegedly “old and well known” features, Applicants respectfully submit that a *prima facie* case has not been established under § 103 with respect to claims 6, 36, and 42.

### **Rejection Should be Withdrawn**

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

#### **Fredlund/Komatsu**

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fredlund in view of U.S. Patent No. 4,817,050 to Komatsu et al. (hereafter “Komatsu”). Applicants respectfully submit that Komatsu fails to remedy the deficiencies of Fredlund as set forth above in connection with independent claim 1. The Examiner only relies on Komatsu to teach “a database system that contains a counter that transfers data from one filing system to another after a predetermined period of time lapses.” Since this does not remedy the deficiencies of Fredlund, Applicants respectfully submit that claim 3 is allowable at least by virtue of its dependency on claim 1. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

#### **Allen/Fredlund**

Claims 18-22, 25-27, and 37-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,737,491 to Allen et al. (hereafter “Allen”) in view of Fredlund. This rejection is respectfully traversed.

### **References Fail to Teach/Suggest Every Claimed Feature**

Independent claim 18 recites that a digital camera automatically transmits a plurality of images to an external apparatus in accordance with an instruction determined by a user in advance. Similarly, claim 21 recites a capturing device that automatically transmits a plurality of images to an external apparatus in accordance with an instruction determined by a user in advance. The Examiner admits that Allen fails to disclose these features (see Office Action at page 9, 1<sup>st</sup> paragraph, and page 10, 2<sup>nd</sup> paragraph). However, the Examiner relies on Fredlund for this feature, asserting that

“Fredlund does teach the feature of carrying out image orders manually by the photofinisher or automatically.” Applicants respectfully disagree.

As discussed above, Fredlund does not automatically transmit images from the customer’s digital camera to the photofinisher. Instead, Fredlund teaches that the customer must manually send the negative film to the photofinisher to scan the images (see step (1) in Synopsis of Fredlund above). At most, Fredlund teaches that, after steps (1)-(3) are performed, a computer in the photofinisher may automatically carry out the image order, by controlling the print server and/or CD writer. Thus, Fredlund fails to teach or suggest automatically transmitting images from a digital camera or capturing device to an external apparatus.

### **Combination of Allen and Fredlund is Improper**

Furthermore, Applicants respectfully submit that the Examiner’s proposed combination is improper under § 103. According to MPEP § 2143.01.V,

If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Applicant respectfully submits that the proposed modification by the Examiner of Allen would render Allen unsatisfactory for its intended purpose and thus is not sanctioned by the provisions of § 103.

Particularly, Allen discloses that speedy delivery of photographs is important. To achieve this objective, Allen teaches that verbal commands are used (Table 1). Thus, Applicants respectfully submit that the speedy selection of images to be transmitted to the photo editor is an essential aspect of Allen. However, if Allen was modified to automatically send all captured images to the photo editor, Applicants submit that the intended purpose of Allen (speedy selection) would not be possible because the photo editor would receive too many images. Thus,

Applicants respectfully submit that Allen actually teaches away from the claimed invention, as well as the Examiner's proposed modification.

At least for the reasons set forth above, Applicants respectfully submit that claims 18 and 21 are allowable. Accordingly, claims 19, 20, 22, 25-27, and 37-40 are allowable at least by virtue of their dependency on claims 18 and 21. Thus, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **Allen/Komatsu**

Claims 23 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allen in view of Komatsu. Applicants point out that claims 23 and 24 are dependent upon claim 21 and, thus, incorporate all of the limitations of claim 21. Further, as acknowledged by the Examiner, Allen does not teach automatically transmitting a plurality of images (see Office Action at page 10, 2nd paragraph). Applicants respectfully submit that Komatsu does not remedy this deficiency. Specifically, Komatsu fails to teach or suggest automatically transmitting images from a capturing device to an external apparatus. Thus, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **Fredlund/Allen**

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Fredlund in view of Allen.

### **No Motivation for Proposed Combination**

Initially, Applicants point out that the Examiner has failed to provide a motivation for the proposed modification of Fredlund in view of Allen. Instead, the Examiner merely asserts that it would have been obvious to modify Fredlund to include a method of transmitting images via a cellular phone, without providing any motivation for doing so. Accordingly, Applicants



respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness against claims 31-35.

### **References Fail to Teach/Suggest Every Claimed Feature**

Further, Applicants respectfully submit that Allen fails to remedy the deficiencies of Fredlund, as set forth above in connection with independent claim 28. Specifically, the Examiner admits that Allen fails to teach or suggest automatically transmitting images (see Office Action at page 9, 1<sup>st</sup> paragraph, and page 10, 2<sup>nd</sup> paragraph).

### **Rejection Should be Withdrawn**

Thus, claim 29 is allowable at least by virtue of its dependency on claim 28. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **Fredlund/Allen/Enomoto**

Claims 31-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fredlund, Allen, and Enomoto. This rejection is respectfully traversed.

### **No Motivation for Proposed Combination**

Initially, Applicants respectfully submit that the Examiner has failed to provide any motivation for combining Fredlund and Allen. Thus, Applicants respectfully submit that this rejection is improper.

### **References Fail to Teach/Suggest Every Claimed Feature**

Furthermore, independent claim 31 has been amended to recite that a plurality of images are automatically transmitted as digital data from a plurality of digital cameras. As discussed above, this feature is not disclosed in Fredlund, Allen, and Enomoto.

At least for the reasons set forth above, Applicants respectfully submit that independent claim 31 is allowable. Accordingly, claims 32-34 are allowable at least by virtue of their dependency on an allowable claim. Thus, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### *Conclusion*

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but to merely show the state of the art, no comment need be made with respect thereto.

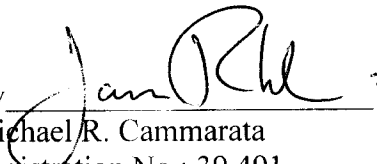
In view of the above remarks, it is believed that the claims clearly distinguish over the patents relied on by the Examiner, either alone or in combination.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: January 22, 2007

Respectfully submitted,

By  #47,305  
for Michael R. Cammarata  
Registration No.: 39,491  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant